

REMARKS

The last Office Action of October 3, 2007 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim 24 is the only claim pending in the application. Claim 24 has been amended. No amendment to the specification has been made. No fee is due.

Record is made of a second interview conducted by phone with applicant's representative and the Examiner on July 19, 2007. During the phone interview the application was extensively discussed. The Examiner is thanked for her help and assistance as well as the courtesies extended to counsel at that time.

Specifically, during the interview the Examiner noted that the claim could be further narrowed by using "consisting of". Furthermore, the Examiner stated that a declaration showing unexpected results could support the distinction relative to the prior art, which was also restated in the Office Action. Applicant now submits a declaration by one of the inventors in support of allowance.

The Examiner also required a priority document. Applicant hereby submits the certified German priority document together with a suitable translation.

Claims 22-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gurunathan et al. (1997) J. Exp. Med., Vol. 186 (7), 1137-1147 ("Gurunathan") in view of U.S. Patent No. 6,451,593 to Wittig ("Wittig")

Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Gurunathan in view of Wittig and Makkerh (1916) Current Biology, Vol. 6 (8), 1025-1027.

Claim 24 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Claim 24 stands rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

REJECTION OF CLAIM 24 UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claim 24 which is the only claim in the application has been amended to delete the objected to language and to more clearly encompass the invention. Thus, claim 24 now clearly expresses that the oligonucleotide as set forth in the claim consists of the SEQ ID NO 3. Support for the language is found on page 6, lines 22-24 of the description.

As a result of the amendment the rejection under 35 U.S.C. §112, first paragraph has become moot and withdrawal of the rejection of claim 24 under 35 U.S.C. §112, first paragraph is respectfully requested.

REJECTION OF CLAIM 24 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claim 24 which is the only claim in the application has been amended to more clearly encompass the invention. Thus, claim 24 now clearly expresses that the oligonucleotide as set forth in the claim consists of the SEQ ID NO 3.

As a result of the amendment to claim 24 the rejection under 35 U.S.C. §112, second paragraph has become moot.

REJECTION OF CLAIMS 22-23 UNDER 35 U.S.C. §103(a) AS BEING UNATENTABLE OVER GURUNATHAN IN VIEW OF WITTIG

In view of the cancellation of claims 22-23 rejection of claims is moot.

REJECTION OF CLAIM 24 UNDER 35 U.S.C. §103(a) AS BEING UNATENTABLE OVER GURUNATHAN IN VIEW OF WITTIG and MAKKERH

With respect to the Examiner's newly cited rejection, applicant notes that the Examiner has conceded that Wittig does not specifically teach covalently

attaching an oligopeptide consisting of SEQ ID NO. 3 and conceded that Gurunathan teaches a DNA plasmid not covalently linked to an oligopeptide.

This combination is flawed. Gurunathan teaches exactly that which in the present disclosure was described a problematic, namely the use of a eukaryotic plasmid. Ergo, the skilled artisan would definitely not start out with that teaching. Wittig on the other hand uses a DNA construct without these former problems. However Wittig does not address the problem which the invention tries to solve. This is further supported by the Declaration of one of the inventors submitted herewith, in which it is shown that the improved results in vaccination were unexpected. Now the Examiner cites the Makkerh reference showing that a NLS sequence was known. Applicant acknowledged as much in the specification on page 6, line 1 of last paragraph. Nothing in the Makkerh reference shows that this particular sequence was used in the experiments as conducted by Makkerh, since as best understood Makkerh was only an investigation into NLS tolerance to mutation and adds nothing to the present invention.

Consequently, it is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982. There is no teaching or suggestion in either reference supporting the combination as proposed by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902. While the Supreme Court in *KSR*¹ rejected a rigid application of the TSM test, a reference must still provide a teaching motivation or suggestion why the reference may be modified. This is not found here.

In view of the foregoing discussion, applicant believes that the prior art in no way renders the invention obvious. Moreover, the declaration of Dr. Marcos

¹ See *KSR Int'l v. Teleflex Inc.*, 127 Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007)

Timon-Jimenez, in which the unexpected results are demonstrated, supports this position.

Withdrawal of the rejection of claim 24 as being obvious under 35 U.S.C. §103(a) over Gurunathan, Wittig and Makkerh is thus respectfully requested.

PRIORITY

In response to the Examiner's comments regarding the priority, applicant submits herewith a certified copy of the German priority document together with a suitable translation.

CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a method as claimed to administer a vaccine of the type as set forth in claim 42 and 43.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant

would greatly appreciate such a telephone interview.

Respectfully submitted,

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